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United States Department of Commerce
PATENT AND TRADEMARK OFFICE
401 Dulany Street
Alexandria, VA 22313

RE: *Final Office Action for 10/800290*

Dear Sir/Madam:

The enclosed document was received in our office on November 17. We believe we have received this document in error.

If you have any questions or concerns regarding this matter, please feel free to contact our office at the number above.

Sincerely,

MERCHANT & GOULD
Prosecution Docket Department


Enclosure

Minneapolis/St. Paul
Denver
Seattle
Atlanta
Washington, DC



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,290	03/12/2004	Zoltan G. Toth	2664/63006	8258
26646	7590	11/03/2006		
KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				
				
			EXAMINER	
			DESAI, RITA J	
			ART UNIT	PAPER NUMBER
			1625	
DATE MAILED: 11/03/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary



Application No.

10/800,290

Applicant(s)

TOTH ET AL.

Examiner

Rita J. Desai

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

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DETAILED ACTION

Claims pending 1-72.

The rejection of the claims 1-72 under 35 USC 103 over US 6, 506,767 (and WO '450) still stands.

Applicants are arguing that the examiner has not made a Prima facie case.

Changing solvents for recrystallization is routine to those skill in the art.

To show the state of the art the Examiner Quotes Dr. Elias Corey.

In *Eli Lilly and Co. v. Barr Laboratories Inc.*, 58 USPQ2d 1869 at 1873,

U.S. Court of Appeals Federal Circuit determined that "choosing a suitable recrystallization solvent was well known to one of ordinary skill in the art. In particular, Dr. Elias J. Corey ("Corey"), a Nobel laureate, testified that fluxamine hydrochloride is "generally quite easy to purify by recrystallization". Corey also explained that, although it requires some experimentation, selecting a recrystallization solvent is "very straightforward". Thus, changing the recrystallization solvent would be routine experimentation for the average BS process chemist seeking to achieve higher yields or a higher purity and thereby reduce costs.

Also see In re Aller et al 105 USPQ 233 which states that selection of reaction conditions is merely optimization of routine experimentation.

Applicants argue that Polymorphism and polymorph generation are considered to be unpredictable by those skill in the art. In some cases it may be so however applicants are not making 'new' polymorphs. They are the same form I and II and mixtures of them.

Claims 1-72 all recite changing conditions that are a routine experimentation. Grinding, using solvents heating and then cooling it suddenly to a lower temp , is also clearly shown in the

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reference see examples 4 and 5. on page 18 of the WO '450 patent. Or column 11 of the US '767 patent. Applicants examples are also drawn to heating and then cooling the solid.

Applicants definition of anti-solvents includes solvents, thus applicants arguments that using anti-solvents and seeding is not suggested is not convincing. These are routine experimentation for one skilled in the art.

Applicants arguments are not found to be persuasive and the rejection still stands.

Conclusion

Claims 1-72 are rejected.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rita J. Desai whose telephone number is 571-272-0684. The examiner can normally be reached on Monday - Friday, flex time..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas McKenzie can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Rita J. Desai
Primary Examiner
Art Unit 1625

R.D.
October 27, 2006

R. Desai
10/27/06